

Appl. No. 10/716,553
Amdt. Dated March 11, 2005
Reply to Office action of November 2, 2004

Amendments to the Drawings:

The attached sheets of drawings include changes to Fig. 1. These sheets, which include Figs. 1-8 replace the original sheets including Figs. 1-8.

Attachment: Replacement Sheets
Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

The Office Action indicates that it is responsive to communications filed June 16, 2004. As such, it is assumed that the Office Action was prepared and mailed before receipt of applicant's communication mailed October 21, 2004 and received in your office of October 22, 2004. This communication requested that the benefit of an additional priority claim be added to the application, namely the benefit of the priority date of U. S. provisional application serial no. 60/516,283 filed November 3, 2003. As noted in the October 21, 2004 communication this request was submitted within the relevant time period, so that no additional surcharge was required.

It is noted that your office has since issued a corrected Filing Receipt recognizing the claim to priority from the provisional application serial no. 60/516,283.

The Examiner argues that applicant had failed to comply with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(c). More specifically, the Examiner is arguing that a "specific reference to the earlier application must be made in the instant application". Firstly, it is acknowledged that for claiming priority from a non-provisional application, the instant application would be required to be amended to include such a reference. Thus, the Examiner correctly identified that for such a claim under "35 U.S.C. 120, 121 or 365(c)", the reference must include the relationship to the application.

However, it is submitted that there is no such requirement for a claim priority from a provisional application. The Examiner's attention is drawn to Section 202 of MPEP. MPEP 202.1 refers to 37 CFR 1.78. A review of Rule 1.78 will show that this rule is entirely concerned with "non-provisional" applications. Thus, 37 CFR 1.78f(2)(i) states that "any application claiming the benefit of one or more prior-filed co-pending non-provisional applications...must contain or be amended to contain the reference to each such prior-filed application" (emphasis is added). It is well accepted that there is no requirement to amend an application to contain a reference to a provisional application.

The Examiner referred to 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii), but it is not seen how either of these sections contain any provision for inserting a reference to a provisional application.

It is submitted that Applicant has met all the requirements for claiming priority from a provisional application, and that the Examiner is requested to withdraw the request to insert a reference to the provisional application.

In the Drawings

The Examiner had requested that Figure 1 be designated by the legend "prior art". Applicant now encloses formal drawings, with Figure 1 amended to include such a legend. It is believed that these formal drawings deal with all the concerns raised in the Patent Drawing Review Notice.

In the Disclosure

Firstly, it is noted that the original paragraph numbering the specification, inadvertently, was not continuous. Thus, paragraph [0100] follows paragraph [0015]. However, as each paragraph was distinctly numbered and to avoid any confusion, the original paragraph numbering scheme is retained.

Paragraph [0006] of the original application was, also inadvertently, incomplete. This paragraph is now being completed by the insertion of the text of amended claim 1. It will be understood that was intended to be a standard counterpart to the main claim of the application. Paragraphs [0110] and [0119] are both being amended simply to include a reference to a "mechanism". Claim 1 as amended below, and as discussed below, now includes a reference to a "mechanism", rather than the earlier term in the original claim 1 "linkage", simply to indicate the mechanical connection between the different components of a pilot valve. No new matter has been added, and this amendment is solely intended to ensure consistency between the disclosure and the claims.

Paragraph [0103] has been amended to correct obvious typographical errors in references 120a, 120b.

Paragraph [0127] has been amended, as requested by the Examiner to replace the reference to "Figure 4" by reference to "Figure 8".

In the Abstract

The abstract is being amended as requested by the Examiner, to remove the reference to legal phraseology, so as to be in full compliance with the Rules.

In the Claims

The Examiner had correctly noted that claims 2–4 do not include any proper dependencies. For simplicity of amendment, these claims are being deleted and a proper set of dependent claims are being inserted as claims 5–14. No new matter has been added, and the subject matter of these claims is clearly derived from the original disclosure. As detailed below.

Rejection of the Claims under 35 U.S.C. 102

Claims 1–3 stand rejected under 35 U.S.C. 102(b) in view of the French reference 1,110,070. Fundamentally, it is submitted that the Examiner has misconstrued this reference, and his analysis of this reference is largely based on a hindsight analysis incorporating significant elements of the present invention.

The Examiner argued that the French reference discloses a pressure regulator (2') and an inspirator (10) similar to those of the present invention. The Examiner further argued that it disclosed a primary pilot (7') also similar to the present invention. In fact, the configuration of these elements that their intended function is quite different from the present invention.

Firstly, the French reference is concerned with the supply of gas to streetlights. As such, it is intended to respond to a pressure pulse, to generate a stronger pulse, for igniting the streetlights. It can be noted that the arrangement is entirely self-contained and contains no input for supply of a "target" pressure. Otherwise, the whole valve arrangement simply responds to changes in pressure in the

duct (3). As a necessary consequence of this arrangement, there is no separate source of actuator fluid.

If one looks at the configuration of Figure 2, the intention is so that the a pressure pulse sensed in the pipe (3) travels up the pipe (20), and then travels through the valve (8'), inspirator (10) and pipe (21) to the main pressure regulator (2'). This causes the main valve (2') to close.

At the same time, the pressure pulse activates a timer (5), which opens the valve (6). When the valve (6) is open, this simply vents the valve (8) to atmosphere through the pipe (23); note that there is no separate supply of actuator fluid or the like through the pipe or connection (23).

The effect of this is to open the valve (8) and permit gas to flow from the inlet pipe (1) through pipe (22) through the inspirator (10), valve (8') to the pipe (20).

With the flow through inspirator (10), the pressure in the chamber (7) of the pressure regulator (2') is reduced, promoting the pressure regulator or valve (2') to open, while the timer (5) is running. At the end of the period set by the timer (5), the valve (6) closes, which in turn closes the valve (8) to close, closing off the flow to the inspirator (10) and thereby causing the valve (2') to close.

The Examiner in paragraphs 11(c) and (d) of the Office Action identified "a primary pilot (7')" and "a secondary pilot (8)". This is confusing. Figure 2 of the French reference shows two valves (8) and (8'), both of which include a chamber (7'). In the following, it is assumed that the Examiner intended to identify the valve (8') as the primary pilot.

This configuration is quite different from the present invention. The primary pilot (116) of the present invention is subject to the pressure upstream of the valve (112); in contrast, the reference, the primary pilot (8') is subject to the pressure downstream from the valve (2').

Similarly, there are significant differences between the secondary pilot (118) of the present invention and the secondary pilot (8) in the French reference, as identified by the Examiner. Thus, the so-called secondary pilot (8) is connected upstream of the valve (2') and is not connected to any target pressure source. It

responds solely to pressures upstream and downstream of the valve (2'), and is subject to the opening and closing of the valve (6) by the timer (5).

In contrast, the secondary pilot (118) of the present invention is subject to a target pressure from the input 170, and contains no connection to the main conduit upstream or downstream of the valve (112). Rather, the configuration of the present invention is intended solely to ensure that a desired pressure of actuator fluid is maintained, at the inlet to the inspirator (114). This configuration is wholly different from the reference.

It can also be noted that the so-called primary pilot (8') in the reference also contains no input for a target pressure.

Accordingly, it is submitted that claim 1 as amended is clearly novel within the meaning of U.S.C. 102 over all the known art.

The Examiner had also relied upon U.S.C. 103(1) to reject claim 4 as being obvious over the French reference 1,110,070, further in view of Yonnet US 5,460,196. Former claim 4, now the subject of claim 5, provides the feature of the actuator fluid supply being independent from the process fluid stream.

It can first be noted that the Yonnet proposal is concerned with a wholly different field, namely a water supply system, characterized as "mains water" (see column 1, lines 1-17). It is therefore submitted that the French patent and the Yonnet patent constitute non-analogous art.

The Examiner referred to a passage in column 10 of the Yonnet patent, for disclosing that an alternative pressure source could be used, but it can be noted that, apart from this incidental reference to an alternative pressure source, Yonnet is consistent in the drawings in showing no alternative pressure source.

It is well established that, for a proper finding of obviousness under 35 U.S.C. 103, there must be (1) Some reason or basis for making the proposed modification; and (2) The proposed modification must not destroy the function of the primary reference.

Dealing with the second point first, it is not seen how an alternative pressure source could be introduced into the French reference, while retaining the basic

function and purpose of the apparatus disclosed. As noted, this French patent is concerned with responding to a pressure pulse, to generate a larger pressure pulse, to assist in lighting streetlights. Introducing an independent supply of "actuator fluid" or the like, would simply destroy this function.

With respect to the first requirement noted under 35 U.S.C. 103, it is submitted that, for similar reasons, there are simply no reason or basis to consider such a proposed modification. The two references are non-analogous art, one is concerned with gas supplied to street lights and the other is concerned with a water supply, and the proposed modification would have no use or function in the context of the gas supply of the French reference.

Accordingly, it is submitted that the claims as submitted are clearly distinguished from the known art, and early review and allowance are requested.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Attachments